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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,838	09/15/2003	Laurence F. Lyons	046374-0117	1220
26371	7590	03/24/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,838

Applicant(s)

LYONS, LAURENCE F.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-24 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 30, 2005.

Claims 1 and 14 were amended, claims 2 and 25 were cancelled and claims 32-34 were added rendering claims 1, 3-24 and 26-34 pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 'the third floor is formed from a material distinct from the first layer and is highly resistant to moisture permeability' is not supported by the specification.

Claim Rejections – 35 USC 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 34, there is insufficient antecedent basis for the phrase "third floor".

Objection

6. Claim 30 is objected to. In instant claim 30, the phrase "U.S. perm rating" should be --U.S. permeability rating--. Appropriate correction is required.

Claim Rejections – 35 USC § 103(a)

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-24 and 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartkemeyer (U.S. 4,684,562).

Hartkemeyer discloses a floor underlayment comprising an intermediate layer made of cork (first layer) disposed underneath a top sheet (third layer) and a liquid resistant bottom sheet (second layer) constructed of foam material, where the three layers are bonded together by an adhesive applied between the sheets (column 2, lines

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20-37) where the mat is bonded to a base, such as a garage floor (column 1, lines 8-11 and 50-54) which are known to be concrete. Hartkemeyer further discloses the top layer can be formed of cardboard (column 3, lines 5-6) which is a thick cellulose fiber (wood pulp) material. Cardboard has a high degree of resistance to moisture upon initially being exposed to moisture and depending upon the amount of moisture that comes in contact with the cardboard material. Cork (first layer) and cardboard (third layer) both conventionally comprise cellulose material, which are common materials. The combination of cork, cardboard and foam materials are sufficiently flexible materials, which are capable of being rolled.

Because Hartkemeyer discloses a first and second layer bonded together, as claimed, the peel strength of the bond and permeability rating are expected to be the same as instantly claimed. Hartkemeyer does not explicitly disclose width or thickness. Such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the width and thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. width and thickness) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the durability of the flooring system. It would have been obvious to one of ordinary skill in the art to make the flooring system with the limitations of the width and thickness since it has been held that discovering an

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optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

9. Arguments made regarding rejection made under 35 U.S.C. 102(b) as being anticipated by Hartkemeyer (U.S. 4,684,562) has been considered and is withdrawn due to Applicant including the limitation of claim 2 in independent claim 1.

Arguments made regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Hartkemeyer (U.S. 4,684,562) has been considered but is unpersuasive. Applicant argues Hartkemeyer does not disclose a first layer having a high degree of resistance to moisture permeability. Hartkemeyer discloses the top layer can be formed of cardboard (column 3, lines 5-6) which is a thick cellulose fiber (wood pulp) material. Cardboard has a high degree of resistance to moisture upon initially being exposed to moisture and depending upon the amount of moisture that comes in contact with the cardboard material. Applicant further argues Hartkemeyer does not appear to be sufficiently flexible so as to be rolled. The combination of cork (layer 1), cardboard (layer 3) and foam (layer 2) materials are sufficiently flexible materials, which are capable of being rolled. Applicant argues the first and third layers are not formed of common materials. Cork (first layer) and cardboard (third layer) both conventionally comprise cellulose material, which are common materials. Regarding claim 14,

Hartkemeyer discloses the top layer can be formed of cardboard (column 3, lines 5-6) which is a thick cellulose fiber (wood pulp) material. Where the wood pulp material is located above the floor underlayment.

Arguments made regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Hartkemeyer (U.S. 4,684,562) in view of Thiers (U.S. 6,786,019) have been considered and is withdrawn due to a lack of proper motivation to combine the moisture proof top layer of Theirs on the flooring system of Hartkemeyer.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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